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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,117	12/22/2000	Laurence D. Hardesty	857-P-4	1034

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/747,117	Applicant(s) HARDESTY ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-36 and 38-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-36 and 38-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | _____ Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| _____ Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12, 28-30, 32, 35 and 45-47 rejected under 35 U.S.C. 102(b) as being anticipated by Hartt et al. (WO 94/04979).

As per claim 1, Hartt et al disclose a financial transaction system utilized by a plurality of participating consumers and benefit sponsors comprising:

- (a) establishing an investment account for the benefit of a participating consumer (see the abstract);
- (b) providing a plurality of benefit sponsors that offer goods and services to the participating consumer (abstract and figure 1) ;
- (c) establishing an authorized payment method for the sale of said goods and services to the participating consumer (such as cash or credit/debit cards or electronic money);

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(d) tracking the qualifying activity that results in the participating consumer being entitled to receive a deposit into or a disbursement from said investment account (page 4, lines 20-29); and

(e) providing a specified benefit to the participating consumer for utilizing the authorized payment method when purchasing goods and services, said benefit comprising a monetary rebate deposited into the participating consumer's investment account (page 3, lines 13-16 and page 4, lines 13-20).

As per claim 2, Hartt et al. disclose reporting on and accounting for the activities that result in the participating consumer being entitled to receive a deposit into, or disbursement from, said investment account (See page 4, lines 20-29).

As per claim 3, Hartt et al. disclose implementing a deposit into, or disbursement from, said investment account (see page 4, lines 2-29).

As per claim 4, Hartt et al. disclose the participating consumer's investment account is established and administered in a manner that the investment account is entitled to accumulate income and gain on a non-tax deferred basis (see page 4, lines 13-19);

As per claim 6, Hartt et al. disclose the investment account is held and administered by a third party acting in a fiduciary capacity with respect to the investment account and the participating consumer. (page 4, lines 5-12).

As per claim 7, Hartt et al. disclose an individual may apply to become a participating consumer by providing specified information and wherein each resulting participating consumer is assigned identification indicia unique to the system. (Note page 5, lines 1-25).

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As per claim 8, Hartt et al. disclose qualifying activity of the participating consumer to the appropriate benefit sponsor. Note page 4, lines 20-29.

As per claim 10, Hartt et al. disclose reporting qualifying activity of the participating consumer to the participating consumer. Note page 4, lines 20-29.

As per claim 11, Hartt et al teach having an escrow account in a financial institution to hold funds and having an investment fund for investing purposes. See page 3, lines 1-21.

As per claim 12, Hartt et al. disclose providing participating consumers with non-monetary incentives relating to goods and services offered by benefit sponsors. Note page 6, lines 26-31.

As per claims 28-30, Hartt et al disclose the system has access to transaction data such that the system can track and account for the participating consumer's purchase of the predetermined good or service. Note page 3, lines 4-14 of Hartt et al.

As per claim 32, Hartt et al disclose the participating consumer is entitled to receive an incremental investment account benefit by engaging in a designated qualifying activity not requiring the purchase of goods or services. See page 4, lines 27-29 of Hartt et al.

As per claim 35, Hartt et al disclose transferring funds via an electronic transfer means. See page 4, lines 5-12.

As per claim 45, Hartt et al disclose discloses a computer-based system operated for the benefit of a plurality of participating consumers and benefit sponsors (see the abstract) comprising:

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(a) means for acquiring required data for each participating consumer (page 4, line 30 to page 5, line 15);

(b) means for acquiring required data for each benefit sponsor (page 6, lines 10-19);

(c) means for acquiring the data required to track the qualifying activity of each participating consumer (page 3, lines 1-21);

(d) means for storing the data described in (a) through (c) as all these data are stored (see figure 1)

(e) means for processing the data described in (a) through (c) such that investment account benefits are calculated, the investment account benefits being monetary rebates paid by a benefit sponsor on qualifying activity (see page 3, lines 1-20 and page 4, lines 20-29);

(f) means for reporting the results of (e) to participating consumers, benefit sponsors and investment account custodians (page 4, lines 1-29);

(g) means for responding to inquiries from participating consumers (page 4, lines 1-29 and figure 1)

(h) means for responding to inquiries from benefit sponsors (figure 1);

(i) means for acquiring the data necessary to, track, approve, and report on an addition to or a disbursement from an investment account (figure 1 and page 3, lines 1-29);

(j) means for implementing an addition to or a disbursement from an investment account (page 3, lines 13-16 and page 4, lines 16-19); and

(k) means in (a) through (j) comprised of coded instructions that are executed by a group of computers (figure 1).

As per claim 46, Hartt et al teaches the instruction comprises a plurality of machine readable instructions which, when executed by a discrete group of computers and related electronic devices, operating in tandem, causes such computers to perform each of the steps as set forth in (a) through (j). Note figures 1 and 2.

As per claim 47, Hartt et al teach the system of claim 45 wherein a comprehensive and fully integrated computer and global communication system implements, operates and administers the system. See figures 1 to 2 and pages 3-6.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 13-14, 31, 33, 34, 39 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartt et al. (WO 94/04979).

As per claim 5, the participating consumer's investment account being pooled with like investment accounts of other participating consumers is not explicitly stated in Hartt et al. The Examiner notes that these are known investment strategies that would have been obvious to one of ordinary skill in the art at the time of the invention to include

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such in the system of Hartt et al. in order to provide more funds into a type of investment.

As per claim 13, Hartt et al do not explicitly disclose providing participating consumers with promotions relating to goods and services offered by benefit sponsors. Providing consumers with promotions relating to goods and services by a merchant is well known in methods of conducting business. It would have been obvious to one of ordinary skill in the art at the time of the invention to do the same in the system of Hartt et al in order to induce customers to purchase and/or to preserve customer loyalty.

As per claim 14, Hartt et al do not explicitly state providing customer service support to participating consumers by established communication systems. Hartt et al disclose communicating with a consumer or participant. The Examiner asserts that customer support service is of prime importance to the success of a business. Providing customer service support in the system of Hartt et al. would have been obvious to one of ordinary skill in the art at the time of the invention in order to enable instant customer satisfaction and customer loyalty and to inform customers of upcoming events or changes.

As per claim 31, Hartt et al do not explicitly teach a participating consumer receives an incremental investment account benefit in connection with the purchase of a predetermined good or service. Hartt et al teach the participating consumer receives a rebate which is based on a predetermined portion of their purchase payment. See page 3, lines 14-16 of Hartt et al. Providing an incremental investment account benefit in connection with the purchase of a predetermined good or service in the system of Hartt

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et al would have been obvious to one of ordinary skill in the art at the time of the invention in order to provide an incentive to the participating consumer.

As per claim 33, the participating consumer may designate a third party as the beneficiary of the participating consumer's investment account is not explicitly stated in the system of Hartt et al. The Examiner notes that this step is well known in the insurance and investment practices as such would have been obvious to incorporate in the investment scheme of the investment providers of the system of Hartt et al. The motivation would have been to provide investment practices just like a conventional investment firm usually practices wherein an investor may make donations to an entity.

As per claim 34, auditing and reconciliation processes are performed on most banking functions or operations as such would have been obvious to one of ordinary skill in the art to do in the system of Hartt et al. so as to detect errors or fraud.

As per claim 39, Hartt et al do not explicitly teach wherein elected information relating to the spending habits and preferences of participating consumers is accumulated and maintained in a secure electronic environment for use in connection with administering the system and for the exclusive benefit of the participating consumer and benefit sponsor. The Examiner notes that shopping and incentive programs usually keep track of consumers' spending habits and preferences. It would have been obvious to one of ordinary skill in the art to do the same in the system of Hartt et al in order for the system to determine what kind of rebates or discounts or award or promotion program to present to the consumer participant.

As per claim 43, the system of Hartt et al does not explicitly teach the statements are piggyback communications accompanying other communications. It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to have statements are piggyback communications accompanying other communications in the system of Hartt et al in order for both consumers and sponsors to maintain updates of reports and activities throughout the system.

4. Claims 15-27, 36, 38, 40-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartt et al. (WO 94/04979) in view of Burke (US Patent No. 6,112,191).

As per claims 15, 16 and 23, Hartt et al. disclose an individual may obtain information and apply to become a participating consumer through a recruiting subsystem 15. See page 5, lines 9-15 of Hartt et al. Hartt et al also disclose a benefit sponsor applying into the system. Note page 6, lines 3-19 of Hartt et al.. Hartt et al do not explicitly state a consumer or a sponsor may apply via a global communications network. Burke discloses a financial system wherein a consumer purchases goods from a merchant and allocates funds to be applied to an investment account. See the abstract. Burke also discloses the consumer may apply via a global communications network. See figure 2 and column 10, lines 29-45. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Burke into the system of Hartt et al in order to allow a consumer to participate remotely from almost anywhere the customer may have access to a terminal device.

As per claim 17, the teachings of Hartt et al are discussed above. Hartt et al do not explicitly teach a qualifying consumer may apply for and use a payment card as the authorized method wherein a payment card is issued by a benefit sponsor. Burke

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discloses a qualifying participating consumer may apply for and use a payment card as the authorized payment method, which payment card is issued by a benefit sponsor. Note column 10, lines 29-45 and column 11, lines 7-9 of Burke. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Burke into Hartt et al in order to encourage vendors to the system thus, providing consumers for the participating vendors.

As per claim 18, Hartt et al and Burke do not explicitly state “the participating consumer is entitled to receive a predetermined investment account benefit for all amounts spent using the payment card, independent of whether the merchant or service provider that accepts the payment card is also a benefit sponsor”. Hartt et al disclose the participating consumer is entitled to receive a predetermined investment account benefit for all amounts spent”. See page 3, lines 13-16 of Hartt et al. Doing so “independent of whether the merchant or service provider that accepts the payment card is also a benefit sponsor” is not explicitly stated by the combination. Such would have been obvious to one of ordinary skill in the art at the time of the invention to do in the system of Hartt et al and Burke in order to provide participants with incentives whenever they use the cards as a payment mechanism.

As per claims 19 and 20, both Hartt et al and Burke disclose the account to which the funds are deposited are investment accounts that will make profit (or an incremental predetermined investment account benefit) to the participating consumer using the payment card to purchase goods and services from a benefit sponsor. See page 4 of Hartt et al.

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As per claims 21-22, Burke discloses a participating consumer may register and use a payment card as the authorized payment method, which payment card is not issued by a benefit sponsor. Note column 11, lines 30-46 since payment is made using any alternative means for making a payment.

As per claim 24, Hartt et al and Burke do not explicitly state “a participating consumer that also participates in an independent shopping or loyalty program may designate a predetermined portion of the benefits available to such participating consumer under the independent program be directed, as a deposit, into such participating consumer's investment account”. Thus, this claim is directed to a participating consumer obtaining other funds from a given type of source to be invested into his/her account.

Hartt et al disclose a participating consumer or “subscriber may also deposit funds directly into their investment accounts in addition to investing subscriber rebates”. See page 4, lines 18-19 of Hartt et al. Thus, Hartt et al. clearly disclose a participating consumer obtains funds or rebates from other types of sources. It would have been obvious to one of ordinary skill in the art in light of the teachings of Hartt et al to also allow a participating consumer that also participates in an independent shopping or loyalty program to designate a predetermined portion of the benefits available to such participating consumer under the independent program be directed, as a deposit, into such participating consumer's investment account in order to allow a the consumer to have a much more aggressive type of investment by investing more into the investment account.

As per claim 25, both Hartt et al and Burke disclose providing tracking, reporting and accounting for the investment account deposits resulting from a participating consumer's participation in the investment program. (Note page 4, lines 20-29 of Hartt et.

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al. and column 5, lines 51-53 and column 10, lines 55-64 of Burke), but not for the independent shopping or loyalty program. The Examiner asserts that most loyalty programs or shopping programs usually tracks, reports and accounts for to their participants. Doing the same for the independent program would have been obvious to one of ordinary skill in the art at the time of the invention in the system of Hartt et al and Burke in order to diminish the risk of errors in the system and also to provide consumers with updates of all of their accounts.

As per claim 26, Burke discloses the benefit sponsor is a manufacturer of the predetermined good or service. Note column 3, lines 49-63 and column 4, lines 58-62 of Burke.

As per claim 27, Burke discloses the benefit sponsor is a distributor of the predetermined good or service. Note column 3, lines 49-63 and column 4, lines 58-62 of Burke..

As per claims 36, Hartt et al do not explicitly teach electronic transfer means is an automated clearing house (ACH). In the system of Burke, a sponsor processes a participating consumer's investment account benefits via electronic transfer means such as an Automated Clearing House (ACH) or an Electronic Data Interchange (EDI). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Burke into the system of Hartt et al. in order provide a quick and instant way of transferring funds to/from the participant's accounts.

As per claim 38, Hartt et al disclose having an escrow account for transferring funds to/from a consumer participant. Other third parties are not explicitly mentioned in Hartt et al. Burke discloses the designated third parties, acting on behalf of and at the

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direction of benefit sponsors, fund the participating consumer's investment account benefits via electronic means. Note column 4, lines 11-62 of Burke. Combining the teachings of Hartt et al and Burke would have been obvious to one of ordinary skill in the art at the time of the invention in order to assign different tasks to different participating parties thus using less computer resources.

As per claims 40, 41 and 42, Hartt et al do not explicitly teach using wireless technologies or wireless communications for viewing account information. Burke teaches a participating consumer may use various communications devices. Applicant is directed to column 17, lines 60-66 where it is indicated well known medium for conducting electronically financial transactions. Including a pda, a cellular, digital or satellite and wireless communication device in the system of Hartt et al and Burke for viewing or performing the financial transactions therein would have been obvious to one of ordinary skill in the art at the time of the invention in order to make the system versatile thus providing and facilitating the consumer with alternate communications means.

As per claim 44, Hartt et al do not explicitly teach each benefit sponsor may offer a customized account benefit to a participating consumer as a result of the participating consumer's purchase of certain goods or services or other qualifying activity. Hartt et al disclose various qualifying criteria. Note page 4, lines 26-29 of Hartt et al. Burke discloses playing a tune for different participating consumers based on an amount contributed. Note column 8, lines 45-53 of Burke. It would have been obvious to one of ordinary skill in the art at the time the invention was made for a sponsor to offer a customized account benefit to a participating consumer as a result of the participating

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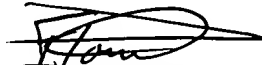
consumer's purchase of certain goods or services or qualifying activity in order to provide a system that attracts a plurality types of participating customers.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628

FP

November 24, 2004